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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

FISCHETTI, JOSEPH A

ART UNIT PAPER NUMBER

3627

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/955,049

**Applicant(s)**

MATSUI

**Examiner**

Joseph A. Fischetti

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 5-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Applicant's election with traverse of claim 2-6 in the reply filed on 6/10/04 and 10/12/04. However, Applicant's argument regarding the predicted search strategies of the Examiner is not deemed persuasive given that a method (e.g. claims 11-15) is a separate statutory class and is not constrained by the physical limitation of a means plus function claim as elected in claims 2-4, and thus the search can be more expansive. The requirement is made FINAL.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 2 is rejected under 35 U.S.C. 102(e) as being anticipated by Revashetti et al.

The preamble successfully integrates the items recited into the body of the claim. Thus, the recitation of "search parameters" in the preamble is read as the "key" that matches the pattern specified by the product signature col. 11, 48-57 and thus is deemed sufficiently integrated with the body of the claim to constitute a limitation. Accordingly, Revashetti discloses an information presentation device 210 in which a user terminal on a network 208 that retrieves products or services comprising:

accepting means for accepting a selection of a product or service that is included in said products or services that were retrieved( is read as the active host program which goes into the client computer 208 to accept the product data on the HD of the computer 208); and parameter storage means for storing the search parameters for the selected product or service as a candidate for purchase (read as inventory database 212 which through detection software detects a product on the client computer), together with user identification information that identifies said user terminal (analysis is particular to a given computer col. 6 lines 61-63 and hence inherently must include identification of the client computer 208).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Revashetti et al. in view of Welsh et al.

Revashetti et al. disclose the invention substantially as claimed as set forth above with respect to claim 2, but not with respect to the limitations of claims 3 and 4.

However, Welsh et al. does disclose does disclose user request accepting means for accepting user reference requests from first group of computer terminals on said network (predictive content system 700 and expert 1206 accepts by monitoring

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reference requests e.g. click stream decisions); Welsh et al. further disclose user reference request parameter providing means for extracting from said parameter storage means a first user identification information identifying said first user terminals that have selected a first product as a candidate for purchase that is provided by an administrator of a provider terminal included in said first computer terminals (PID associates a user with a subset of content categories, content manager matches content choices with the PID see col. 13), and search parameters that each of said first user terminals has set to said first product, and providing them to said provider terminal (based on this association, content system 700 presents a selection of content choices to the user col. 8, 62 et seq.) Welsh et al. further disclose information setting means (PID database 1104 col. 12 line 39) for receiving from said provider terminal the designation of user identification information included in said first user identification information provided to said provider terminal, and product information settings for said designated user identification information (PID obviously includes settings of product information in order to be mapped to see col. 8 line 52); product information storage means for storing said designated user identification information (read as the PIDI data base which also receives the PID data where I indexes a profile), and presentation means (read also as the content system 700 which presents a selection of content choices to the user) for receiving a purchase candidate reference request from a designated user terminal identified by said designated user identification information Regarding the extracting device portion of claim 4, the identifier PIDI is referenced to a product information set and the user it reads on the extraction functions and these

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users identified by the suffix I are or can be presented as a group given the old and notorious use of a sorting function in computers. It would be obvious to modify the system of Revashetti et al with the grouping feature of Welsh et al. as described above, the motivation being the ability to categorized groups of users or people who like a certain product for ease in mass marketing.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication should be directed to PRIMARY EXAMINER Joseph A. Fischetti at telephone number (703) 305-0731.

